



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,746	09/11/2003	Esther Dabney	1266-27	3466
23117 7590 03/04/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
RANKINS, WILLIAM E				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
03/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/659,746

**Applicant(s)**

DABNEY ET AL.

**Examiner**

WILLIAM E. RANKINS

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-27 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 12/11/2003, 02/16/2005, 05/02/2006 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Status of Claims***

Claims 19-27 and 38 are pending in this application. All claims have been amended.

### ***Response to Arguments***

1. The affidavit filed on 12/15/2008 under 37 CFR 1.131 is sufficient to overcome the 12/30/2002 Yahoo Auctions reference.
2. Applicant's arguments, see pgs. 8 and 9, filed 12/15/2008, with respect to the rejection(s) of claim(s) 19, 20 and 38 under 102(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 102(b).

3. Applicant's arguments with respect to claims 21-27 have been considered but are moot in view of the new ground(s) of rejection.

4. Official Notice

Examiner took Official Notice as follows [See Office Action, page 11, line 1- 6]:

1. "Official Notice is taken that it is old and well known in the art to offer sellers the ability to re-list an item for free if it does not sell during the allotted auction time.

Here, per MPEP 2144.03, Official Notice is used to establish "facts" without supporting documentary evidence. In particular, said facts should (a) "serve only to 'fill in the gaps' which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection" and (b) should not be "the principal evidence upon which a rejection was based". [see MPEP 2144.03A]. Further, "[i]f such notice is taken, the basis for such reasoning must be set forth explicitly" so that Applicant can "adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made" [MPEP 2144.03B]. In this vein, "[t]o adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include **stating why the noticed fact is not considered to be common knowledge or well-known in the art.**" [see MPEP 2144.03C & 37 CFR 1.111(b), emphasis added]. Here, only "[i]f applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. [see *Id.* & 37 CFR 1.104(c)(2)]. "If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate." [MPEP 2144.03C].

The examiner asserts that the applicant did not challenge the Official Notice taken against claims 26 and 27 and the noticed facts are now applicant admitted prior art.

A review of the claims and updated search necessitated the rejections below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 19-27 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the present case, the claims have been amended to include the word "signals" which is not supported by the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-27 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present case the claims refer to "signals" being transmitted over the network. The specification does not define the word signals. The examiner will assume that the signals are simply the execution of a request as interpreted by and confirmed through the interface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 19, 20 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Churchill et al. (7,461,022).

As per claim 19;

Churchill discloses:

In an online network-connected computer system of the type that receives request signals transmitted over a network from users and responds by providing responsive signals over said network for display by said requesting users, a method of performing computer based processes to processing online auction-style listings and provide associated responsive signals for display, said method comprising (Fig. 1, Col, 16, lines 23-30):

recording a predetermined listing and end time for an auction style listing stored in a computer memory to end (Col. 7, lines 62-67);

receiving, from users over the network, signals representing bids with respect to said auction style listing before said listing and time (col. 9, lines 7-18);

automatically extending said predetermined end time if signals represented a bid

for said auction-style listing are received near the predetermined listing end time (Col. 43, line 20-34 and Col. 44, lines 38-47); and

sending responsive signals to users over the network for display, said sent responsive signals indicating at least that said predetermined end time is extended (Col. 43, lines 20-34 and Col. 44, lines 38-47).

Claim 20 is similarly rejected by the recitation provided for claim 19.

As per claim 38;

Churchill discloses:

In an online network-connected computer system of the type that receives request signals transmitted over a network from users and responds by providing at least signals over said network for display by said requesting users, a method of providing online auction- style listing services comprising:

storing information relating to items for sale auction-style in a computer database;

scheduling auction-style listings and associated end times associated with said listed items; and

posting auction style listings on a web page for viewing by users, said auction style listings soliciting competitive bids while concealing predetermined prices the seller will accept to sell items;

receiving, from users over the network, signals representing competitive bids with

respect to said auction style listings; and

in response to a bid received before the end of an auction style listing, allowing authorized sellers to accept bids and unilaterally end auction-style listings before said end times.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schubert et al. (2002/0116287).

As per claim 21;

Schubert does not specifically disclose:

A computer-based online auction-style listing service comprising:  
maintaining a database of auction-style listings, said database including geographical location of listed items;

a user interface requesting a user to input the user's geographical location, and

receiving signals from the user representing a geographical user location; and

said database searching at least in part in response to the geographical user location representing signals for items that are within proximity to the represented geographical user location; and

sending signals to said user over the network for use in displaying at least primarily items that are within proximity to the specified geographical user location;

wherein said user interface communicates signals with said user to facilitate receipt from the user of signals representing bids on items that are within proximity to the represented geographical user location.

However, Schubert discloses;

An online, tier driven reverse auction (Para. 0010), where it is known in e-commerce to identify merchants in the same locale as the internet customer. The Yahoo portal can provide a list of merchants for a given product or service line within a postal zip code or city by the specified user. It lists approximate distance, maps and directions. EBay also provides a regional option for users who wish to trade or limit their searching within a fixed region (Para. 0008).

The examiner asserts that it would be obvious to one of ordinary skill in the art at the time of this invention that calculations would be useful for determining the distances between locations in order to provide directions, maps and the like.

Claim 22 is similarly rejected by the recitation provided for claim 21.

2. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Churchill et al. (7,461,022) in view of Walker et al. (2002/0147663).

As per claim 23;

Churchill discloses:

In an online network-connected computer system of the type that receives request signals transmitted over a network from users and responds by providing at least signals over said network for display by said requesting users, a method of performing computer based processes to providing signals over the network relating to online auction-style listings, the method comprising (See claim 19 rejection):

maintaining a database of items available for auction-style listing Col. 8, lines 4-13);

Churchill does not disclose;

receiving signals allowing sellers to specify whether items are to be listed in said database as conditional or binding transactions;

in response to user request signals received over the network, generating and sending signals over the network representing displaying of (a) the conditional or binding characteristic of an item listing, and (b) with at least some other information relating to the item; and

receiving further signals representing offers to purchase the item over the network that lead to change in state of the ownership of the item.

However, Walker discloses:

A customer offer to purchase items through an auction where the offer is part of a binding offer or conditional purchase offer (Para. 0115) including an indication of a second customer interest (Para. 0129).

The examiner asserts that it was well known in the art at the time of this invention to display information entered by a user to the user for confirmation and to conduct and complete transactions over the internet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Churchill and Walker to facilitate the satisfactory purchase and sale of items by electronic commerce.

3. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Churchill et al. (7,461,022) as applied to claim 23 above, and further in view of Elias (20010034694).

As per claim 24;

Churchill discloses:

In an online network-connected computer system of the type that receives request signals transmitted over a network from users and responds by providing at least signals over said network for display by said requesting users, a method of providing online listing services and comprising:

maintaining at least one database of items listed for sale;

Churchill does not disclose:

sending, over the network, signals representing a user interface displaying display of at least some of said items in a classified advertising listing format.,

sending, over the network, signals representing a user interface display of at least others of said items in an auction- style listing format; and

allowing sellers, through automatic interaction with the computer system, to select item listings and flexibly change selected item listings between said classified advertising and said auction-style listing formats.

However, Elias discloses;

An online system for a collectibles market place where sellers can flexibly change their listings between classified, barter and auction listings (Para's. 0034, 035 and 0040).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Churchill and Elias to facilitate the sale and purchase of items in an electronic marketplace by providing convenient alternatives to the common auction method of performing transactions which may be more useful and desirable in certain circumstances (Para. 0008).

4. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Churchill et al. (7,461,022) as applied to claim 23 above, and further in view of Fujiwara et al. (20010027433) and Gujral et al (20020042769) and Applicant admitted Prior Art (Official Notice taken in previous office action).

As per claim 25;

Churchill discloses:

In an online network-connected computer system of the type that receives request signals transmitted over a network from users and responds by providing at least signals over said network for display by said requesting users, a method of providing online transaction services comprising: storing auction-style listings in a database; allowing potential bidders to search through and request selectively selective display of at least some of said database contents via signals exchanged over a network; accepting signals representing bids from users and providing signals representing at least some information concerning said bids to corresponding sellers (See claim 23 rejection); and

Churchill does not disclose;

allowing sellers whose items have been bid upon to use the network to issue offers to sell items users have bid on to corresponding bidders while temporarily suspending auction-style listings for predetermined durations, thereby preventing other users from submitting bids on said suspended auction-style listings when corresponding unaccepted offers to sell from sellers to users for said items are outstanding.

However, Gujral discloses allowing a seller to accept a bid prior to the close of the auction and notify other bidders that the auction is closed (Para. 0082).

Fujiwara discloses accepting an offer from a buyer and if the buyer does not respond, reopening the auction (Para. 0051) and advising bidders that an offer has been accepted and preventing more bids from being made (Para. 0015).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Churchill, Gujral and Fujiwara.

One of ordinary skill in the art at the time of this invention would have been motivated to do so according to KSR exemplary rationale E. "Obvious to try" – Choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.

The examiner finds that the common thread between the references and the applicant's invention is a recognized need in the art to improve the efficiency of the auction process and facilitate the purchase and sale of items efficiently and securely at the best possible price for the buyer and seller. The level of ordinary skill in the arts would be provide one with the general knowledge of the finite types of auctions currently in use and the various pros and cons of each type.

As per claim 26;

Churchill does not disclose:

The method of claim 25 further including allowing sellers to issue offers to sell to high bidders before listing expiration, and allowing sellers to issue offers to sell to any bidders after a listing expiration.

However, Official Notice is taken that it was old and well known in the art at the

time of this invention to offer sellers the ability to re-list an item for free if it does not sell during the allotted auction time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods of Churchill, Gujral, Fujiwara and Official Notice in order to promote auction sales.

Claim 27 is rejected under the same rationale used to reject claim 26.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/  
Examiner, Art Unit 3696  
02/24/2009

/Daniel S Felten/  
Primary Examiner, Art Unit 3696